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OFFICE OF PETITIONS

In re Patent No. 6,261,832 :  
Issue Date: 07/17/2001 :  
Application Number: 09/005,035 : DECISION ON PETITION  
Filing Date: 01/09/1998 :  
Attorney Docket Number: :  
038007/0112 :

This is a decision on the petition under 37 CFR 1.378(b),<sup>1</sup> filed on August 13, 2012, to accept the delayed payment of the maintenance fee for the above-identified patent.

The petition is dismissed.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400.00 as set forth in 37 CFR 1.17(f). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

<sup>1</sup> A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must include:

- (1) the required maintenance fee set forth in § 1.20(e) through (g);
- (2) the surcharge set forth in § 1.20(I)(1); and
- (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

The patent issued on July 17, 2001. The first maintenance was timely filed. The second maintenance fee could have been paid during the period from July 17, 2008 through January 21, 2009, or, with a surcharge, during the period from January 22 through July 17, 2009. The patent expired at midnight on July 17, 2009, for failure to timely pay the second maintenance fee.

Petitioner, *pro se*, asserts that his patent maintenance fees had previously been paid by petitioner's patent law firm, Heller Ehrman White & McAuliffe LLP. Petitioner states the law firm went bankrupt and did not advise petitioner of the need to pay the maintenance fee, and that petitioner recently learned that the patent had become expired for nonpayment of the maintenance fee. Petitioner further states that he was in China taking care of his wife's elderly parents.

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable".<sup>2</sup> A patent owner's failure to pay a maintenance fee may be considered to have been "unavoidable" if the patent owner "exercised the due care of a reasonably prudent person."<sup>3</sup> This determination is to be made on a "case-by-case basis, taking all the facts and circumstances into account."<sup>4</sup> Unavoidable delay under 35 U.S.C. § 41(b) is measured by the same standard as that for reviving an abandoned application under 35 U.S.C. § 133.<sup>5</sup> Under 35 U.S.C. § 133, the Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to have been "unavoidable". Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.<sup>6</sup> However, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.<sup>7</sup> In

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<sup>2</sup> 35 U.S.C. § 41(c)(1).

<sup>3</sup> Ray v. Lehman, 55 F.3d 606, 608-09 (Fed.Cir.), cert. denied, -- U.S. ---, 116 S.Ct. 304, L.Ed.2d 209 (1995).

<sup>4</sup> Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

<sup>5</sup> In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (PTO Comm'r 1988).

<sup>6</sup> Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

<sup>7</sup> Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

view of In re Patent No. 4,409,763,<sup>8</sup> this same standard will be applied to determine whether "unavoidable" delay within the meaning of 37 CFR 1.378(b) occurred.

35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was avoidable, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unavoidable.<sup>9</sup> 35 U.S.C. § 133 does not require the Director to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing). Petitioner is reminded that it is the patentee's burden under the statutes and regulations to make a showing to the satisfaction of the Director that the delay in payment of a maintenance fee is unavoidable.<sup>10</sup>

As 35 USC § 41(b) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 USC § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.<sup>11</sup> That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken by the responsible party to ensure the timely payment of the second maintenance fee for this patent.<sup>12</sup>

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.378(b):

- (1) The delay in reply that originally resulted in expiration;
- (2) The delay in filing an initial petition pursuant to § 1.378(b) to revive the application; and
- (3) The delay in filing a grantable petition pursuant to § 1.378(b) to revive the application.<sup>13</sup>

<sup>8</sup> 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), aff'd sub nom. Rydeen v. Quigg, 748 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992).

<sup>9</sup> See Commissariat A. L'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960).

<sup>10</sup> See Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992); Ray v. Lehman, supra.

<sup>11</sup> Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

<sup>12</sup> Id.

<sup>13</sup> See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131 at 53158 (October 10, 1997).

This petition lacks the showing required by periods (1) and (2).

With regards to period (1), petitioner asserts that the patent became expired because petitioner's patent law firm became bankrupt and failed to inform petitioner that the maintenance fee was due. While this is an unfortunate matter, the showing nonetheless is of a failure of communication between attorney and client. Delay resulting from a failure in communication between a client and a registered practitioner is not unavoidable delay.<sup>14</sup> Specifically, delay resulting from a lack of proper communication between a patent holder and a registered representative as to who bore the responsibility for payment of a maintenance fee does not constitute unavoidable delay within the meaning of 35 U.S.C. § 41(c), and 37 CFR 1.378(b).<sup>15</sup> Furthermore, while petitioner allegedly chose to rely upon counsel, such reliance per se does not provide petitioner with a showing of unavoidable delay within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b).<sup>16</sup> Rather, reliance merely shifts the focus of the inquiry from petitioner to whether the practitioners acted reasonably and prudently.<sup>17</sup> Nevertheless, petitioners are bound by any errors that may have been committed by counsel.<sup>18</sup> Petitioners should also note that the U.S. Patent and Trademark Office is not the proper forum for resolving disputes between patentees and their representatives.

Petitioners are reminded that any errors or omissions of petitioners' counsel did not relieve petitioner from its obligation to exercise diligence with respect to this patent.<sup>19</sup> In the absence of an adequate showing of petitioner's diligence in this matter throughout the period in question, the actions or inactions of the registered practitioners will remain imputed to petitioner.<sup>20</sup>

Likewise, petitioner's assertion of diligence in filing the maintenance fee and the present petition after learning of the

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<sup>14</sup> In re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988).

<sup>15</sup> See Ray, at 619, 34 USPQ2d at 1789.

<sup>16</sup> See California Medical Products v. Technol Med. Prod., 921 F. Supp. 1219, 1259. (D. Del. 1995).

<sup>17</sup> Id.

<sup>18</sup> California, *supra*.

<sup>19</sup> Douglas v. Manbeck, 1991 U.S. Dist. LEXIS 16404, 21 USPQ2d 1697, 1700 (E.D. Pa. 1991), *aff'd*, 975 F.2d 869, 24 USPQ2d 1318 (Fed. Cir. 1992) (applicant's failure over two and one half year period, to exercise any diligence in prosecuting his application overcame and superseded any omissions on the part of his representative).

<sup>20</sup> See In re Lonardo, 17 USPQ2d 1455 (Comm'r Pat. 1990).

expiration of the patent does not render the delay unavoidable. The U.S. Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions.<sup>21</sup> Specifically petitioner's delay caused by the mistakes or negligence of their voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. § 41(c)(1) or 37 CFR 1.378(b).<sup>22</sup> Petitioner was not forced, but rather made a conscious decision to obtain the services of the chosen representative in payment of the maintenance fees for this patent, and therefore must be held accountable for his actions, or lack thereof, before the Office.

As such, assuming that the aforementioned law firm had been so engaged, it is incumbent upon petitioner to demonstrate, via a documented showing, that his registered patent attorney or agent had docketed this patent for the second maintenance fee payment in a reliable tracking system.<sup>23</sup> If petitioner cannot establish that his registered patent attorney or agent had been so engaged, then petitioner will have to demonstrate what steps were established by petitioner to monitor and pay the maintenance fee.<sup>24</sup>

The showing of record, however, is that no steps were in place by petitioner or his counsel to monitor and pay the maintenance fee. While it is unfortunate that the patent expired despite petitioners' desire to the contrary, such a showing does not rise to the level of unavoidable delay.

Furthermore, with respect to the delay resulting from petitioner being out of the country and caring for his wife's elderly parents, the Office is mindful of petitioner's predicament. The showing of record, however, is that rather than unavoidable delay, petitioner was preoccupied with other matters during the time the maintenance fees on the present patent were due. Petitioner's preoccupation with other matters which took precedence over timely payment of the maintenance fee in the present patent does not constitute unavoidable delay.<sup>25</sup>

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<sup>21</sup> Link v. Wabash, 370 U.S. 626, 633-34 (1962).

<sup>22</sup> Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891).

<sup>23</sup> Id.

<sup>24</sup> Id.

<sup>25</sup> See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

In summary, while the difficulties encountered by petitioner are certainly unfortunate, a showing of unavoidable delay requires, nonetheless, that petitioner provide a documented showing that he exercised the level of care of a reasonably prudent person acting with respect to his most important business. The showing of record has been considered, but does not rise to the level of unavoidable delay. The petition must therefore be dismissed.

Any renewed petition must be accompanied by evidence supporting a conclusion that the failure to timely pay the maintenance fee was unavoidable.

Petitioner is cautioned to avoid submitting personal information in a patent application that may contribute to identity theft. If personal information such as social security numbers, bank account numbers, or credit card numbers are included in documents submitted to the USPTO (other than a check or credit card authorization form PTO-2038 submitted for payment purposes), petitioners should consider redacting such personal information from the documents before submitting them to the USPTO. This type of personal information is never required by the USPTO to support a petition or an application. Petitioner is advised that any information submitted in an application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, information from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The \$400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

The address in the petition is different than the address in Office records. A courtesy copy of this decision will be mailed to the address in the petition. All future correspondence, however, will be mailed solely to the address of record. A change of correspondence address (form enclosed) should be filed if the correspondence address needs to be updated.

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Douglas I. Wood  
Senior Petitions Attorney  
Office of Petitions

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☐ Attorney or agent of record. Registration Number \_\_\_\_\_

Signature

Typed or  
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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

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This collection of information is required by 37 CFR 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Post Issue, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.